

Appl. No.: 10/616,470  
Reply to Office Action of 05/18/2005

Patent/Docket No. 23834.6  
Customer No. 000027683

### III. Remarks

Claim 1 has been amended to incorporate the limitations of claim 10 which has been cancelled. Claim 11 has been cancelled, and new dependent claim 12 has been added which depends on claim 1. Original dependent claims 6-8 have been amended from a formal standpoint, with the amendment to claim 6 overcoming the rejection under 35 USC § 112. The remaining original claims have been maintained in their original form.

#### Claim Rejections -- 35 USC § 102

Some of the previous claims were rejected under 35 U.S.C. §102(b) as being anticipated by Funk, Borkowski, et al., German 427.6 and German 861. However, these patents are not applicable to amended claim 1 for the following reasons.

Claim 1 now recites a container having a ring pull with an opening, the ring pull being moveable over an outlet of the container, the opening being sized to prevent the ingress of specific foreign objects into the outlet whilst enabling the contents of the container to be poured out, with the ring pull being provided with a pair of depending tangs which project from the underside of the ring pull and into the can and engage opposite sides of the outlet.

The PTO provides in MPEP §2131 that:

*"[t]o anticipate a claim, the reference must teach every element of the claim."*

Therefore, to support these rejections with respect to amended claim 1, the Funk, Borkowski, et al., German 427.6 and German 861 patents each must contain all of the above-claimed elements of claim 1. However, these patents do not disclose a container having a ring pull with an opening, the ring pull being moveable over an outlet of the container, the opening being sized to prevent the ingress of specific foreign objects into the outlet whilst enabling the contents of the container to be poured out, with the ring pull being provided with a pair of depending tangs which project from the underside of the ring pull and into the can and engage opposite sides of the outlet.

Appl. No.: 10/616,470  
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As a result, the previous rejections based on 35 U.S.C. §102(b) cannot be supported by the Funk, Borkowski, et al., German 427.6 and German 861 patents as applied to new claim 1.

### **Claim Rejections – 35 USC § 103**

Applicant does not understand the rejection set forth in paragraph 11 of the office action. In particular, the rejection was based on the patent to Borkowski et al., yet the discussion following the rejection was directed to Funk. However, this is academic since amended claim 1 now distinguishes over both references, taken alone or in combination.

Some of the previous claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Funk and Borkowski, et al. However, this rejection is not applicable to amended claim 1 for the following reasons.

As the PTO recognizes in MPEP §2142:

*The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 1 since 35 U.S.C. §103(a) provides that:

*[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Funk and Borkowski, et al., alone, or in combination, do not teach a container having a ring pull with an opening, the ring pull being moveable over an outlet of the container, the opening being sized to prevent the ingress of specific foreign objects into the outlet whilst enabling the contents of the container to be poured out, with the ring pull being provided with a pair of depending

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Patent/Docket No. 23834.6  
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tangs which project from the underside of the ring pull and into the can and engage opposite sides of the outlet.

Therefore, it is impossible to render the subject matter of claim 1 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Funk and Borkowski, et al. patents cannot be combined and applied to reject claim 1 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

*[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*

Here, Funk and Borkowski, et al. do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing a container having a ring pull with an opening, the ring pull being moveable over an outlet of the container, the opening being sized to prevent the ingress of specific foreign objects into the outlet whilst enabling the contents of the container to be poured out, with the ring pull being provided with a pair of depending tangs which project from the underside of the ring pull and into the can and engage opposite sides of the outlet.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1.

In this context, the MPEP further provides at §2143.01:

Appl. No.: 10/616,470  
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Patent/Docket No. 23834.6  
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*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and the rejection under 35 U.S.C. §103(a) is not applicable.

Based on all of the above, it is apparent that amended claim 1 is now in condition for allowance. Dependent claims 2-9, and 12 depend from, and further limit, independent claim 1 in a patentable sense, and therefore are also deemed to be in condition for allowance.

In view of all of the above, the allowance of claims 1-9, and 12 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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